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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/820,280 | 04/08/2004 | Jack W. Adoline | BGEE 2 00017 | 8603 |
| 27885 7590 04/17/2007 FAY SHARPE LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114 | | | EXAMINER SY, MARIANO ONG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3683 | |

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|--|------------|---------------|
| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
| 3 MONTHS | 04/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,280

Applicant(s)

ADOLINE ET AL.

Examiner

Mariano Sy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 42-96 is/are pending in the application.
- 4a) Of the above claim(s) 33-40, 42-48, 63-71 and 77-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32, 49-62, 72-76 and 84-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/02/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 23, 2007 has been entered.

2. Claims 1 and 49 objected to because of the following informalities:

Claim 1, lines 10-11 "said rod" should be --said rod member--,

Claim 49, line 21 "said rod" should be --said rod member--.

Appropriate correction is required.

3. Claims 29-32 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Since independent claim 1 already recited "said top bushing including a sealing arrangement to inhibit fluid from entering into and escaping from said top end of said housing" in lines 12-13, dependent claims 29-32 will be redundant limitation.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-32, 49-62, 72-76, and 84-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adoline et al. (US 6,773,002) in view of Miura et al. (US 6,315,093).

Adoline et al. disclosed, as shown in fig. 1-5, a spring system comprising a housing 24 having an axis, an internal chamber, and axially opposite bottom and top ends; a rod member 22 having an inner end 22b in said housing and an outer end 22a axially outwardly of said top end of said housing; a guide member 34 on said inner end of said rod member; first 28 and second 30 compression springs each extending between said guide member and the bottom end of said housing; and top 32 and

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bottom 38 bushings, said top bushing including an opening to enable said rod member to pass therethrough, said first and second springs being coaxial with one another and with said axis; at least one of said springs at least partially applying a force on said guide member as said rod member moves between fully retracted and fully extend positions, at least one of said springs having a free length that is a majority length of said internal chamber, both of said springs contacting said bottom bushing when said rod member is fully retracted position, said guide member dividing said internal chamber into at least two sub-chambers, wherein the direction of winding of said first compression spring is opposite the direction of winding of said second spring, the free length of first spring is less than the second spring, the outside diameter of said first spring is less than the second spring, the wire diameter of said first spring is less than the second spring.

However Adoline et al. failed to disclose said top end and bottom end of said housing are sealed, wherein the guide member having a first passageway that include a one way valve and a second passageway spaced from each other and from outer edge of the guide member, and wherein the second passageway has a maximum fluid flow rate that is less than a maximum fluid flow rate of the first passageway.

Miura et al. teaches, as shown in fig. 5, a shock absorber having top end and bottom end of the housing sealed and a guide member 3 having a first passageway 14 that include a one way valve and a second passageway 3c spaced from each other and from outer edge of the guide member, and wherein the second passageway has a

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maximum fluid flow rate that is less than a maximum fluid flow rate of the first passageway.

It would have been obvious to one of ordinary skill in the art to modify the spring system of Adoline et al. having top end and bottom end of the housing sealed and the guide member to include first and second passageway, as taught by Miura et al., in order to seal the inside chamber of the spring system from dirt and moisture and in order to change the damping characteristics of the spring system depending upon the type of application.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 72-78, 90, and 91 of copending Application No. 10/838,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter limitations in claims 72-78, 90, and 91 of copending Application No. 10/838,740 encompass the claimed subject matter limitations in claims 1-13.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Examiner has considered all arguments in the Remarks but are moot based on new grounds of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariano Sy whose telephone number is 571-272-7126. The examiner can normally be reached on Mon.-Fri. from 8:30 A.M. to 2:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon C. Kramer, can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

my M. Sy

April 3, 2007

DEVON C. KRAMER
PATENT EXAMINER

Devon Kramer
4/12/07